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**REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.116
EXPEDITED PROCEDURE
GROUP 3762
PATENT APPLICATION**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q63269

Naoto AKIYAMA, et al.

Appln. No.: 09/800,788

Group Art Unit: 3762

Confirmation No.: 4071

Examiner: Frances P. Oropeza

Filed: March 08, 2001

For: ELECTROTHERAPY APPARATUS AND ITS ELECTRIC ENERGY DELIVERING
METHOD

REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.116

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated June 28, 2004, reconsideration and allowance of the subject application are respectfully requested. Upon entry of this Request, claims 1-40 and 42 are pending in the application with claims 13-35, 37, 38, 40 and 42 withdrawn from consideration as being directed to a non-elected invention. Applicant respectfully submits that the pending claims define patentable subject matter.

Although the Examiner has withdrawn the previous rejections based on Morgan and Cameron, claims 1-8, 36 and 39 remain rejected under 35 U.S.C. § 102(e) as being anticipated by Lyster. However, the Examiner did not acknowledge, address or otherwise respond to Applicant's arguments for patentability in the December 9, 2003 Amendment with regard to the

rejection of claims 1-8, 36 and 39 under 35 U.S.C. § 102(e) as being anticipated by Lyster. That is, the Examiner simply repeats verbatim the same rejection reasons set forth in the July 9, 2003 Office Action. As set forth in MPEP 707.07(f), “[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant’s argument and answer the substance of it.”

In view of the absence of a proper response to the arguments for patentability, the undersigned called the Examiner seeking an explanation for the continued rejection based on Lyster (see Examiner’s Interview Summary Record dated July 26, 2004 and Statement of Substance of Interview filed August 26, 2004). During the telephone conference, the Examiner stated Applicant should file a response to the June 28, 2004 Office Action pointing out the absence of a response and providing the same arguments set forth in the December 9, 2003 Amendment so that she can issue a new action with a proper response.

Applicant again respectfully submits that the claimed invention would not have been anticipated by or rendered obvious of Lyster because the cited reference does not teach or suggest the claimed “means for reversing polarity of the voltage outputted to the output electrode, and outputting at least first phase waveform and second phase waveform to the output electrode”. In rejecting a claim with a “means plus function” limitation, 35 U.S.C. § 112, sixth paragraph, requires that (1) the prior art element perform the identical function specified in the means plus function limitation, and (2) the prior art element’s structure must be the same as or equivalent to the structure corresponding to the claimed means. However, the rejection grounds have not correctly followed this straightforward guidance. That is, in the repeated rejection grounds, the Examiner only generally alleges that Lyster discloses all of the features of invention

recited in independent claims 1 and 2 without specifically identifying which elements of Lyster's defibrillator correspond to the claimed means.

Lyster discloses utilizing a conventional H-bridge circuit formed by four switches to reverse the polarity of the output waveform. On the other hand, the present application teaches utilizing three switches for reversing the polarity of the output waveform. That is, as shown in Figure 1, a positive polarity of the electric energy storage section 104 is connected to an inductor 105 through a switch 101 (the first switch means), and further, the opposite side terminal of the inductor 105 is connected to a negative polarity of the electric energy storage section 104 through a switch 103 (the third switch means). The opposite side terminal of the inductor 105 is connected to the one output electrode 112a to apply an electric stimulation pulse onto the patient 113 (the impedance of the patient is 113a) through a switch 102 (the second switch means), through the inductor 110.

Thus, while Lyster discloses switching circuits which may perform a function similar to that of set forth in the claimed means limitation (i.e., reversing polarity of the voltage outputted to the output electrode, and outputting at least a first phase waveform and a second phase waveform to the output electrode), the rejection position is incorrect since the cited references do not disclose the same or equivalent structure.

MPEP 2183 (A) provides guidance for determining whether the prior art element is an equivalent, which requires that:

the prior art element performs the identical function specified in the claim in substantially the same way, and produces substantially the same results as the corresponding element disclosed in the specification. (Applicants' emphasis).

Since an analysis consistent with this guidance shows that the structure of Lyster does not perform the identical function in substantially the same way, the structure of Lyster is not an equivalent.

Accordingly, Applicant respectfully submits that the claims 1-12, 36 and 39 should be allowable over the cited reference.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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Date: September 28, 2004

Attorney Docket No.: Q63269